



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/575,431

04/10/2006

Jiro Kiyama

65325 (70904)

2093

21874

7590

06/25/2010

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

HARVEY, DAVID E

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

06/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,431	Applicant(s) KIYAMA ET AL.	
	Examiner DAVID E. HARVEY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date : 6/15/2010, 1/15/2010, 4/7/2009, 3/31/2008, 7/10/2006, 10/10/2006, 4/10/2006.

Art Unit: 2621

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 59 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) With respect to claim 59:

As currently drafted, claim 59 depends from canceled claim 1 which makes claim 59 clearly indefinite. For the purpose of this action, it has been assumed that claim 59 actually depends from claim 59.

B) With respect to claim 61:

1) In line 1, "for storing" is indefinite because it is not clear if the listed types of information are actually stored on the medium or if they merely represent information that is intended to be stored on the medium.

2) In line 3-4, "are able to be supplied to a content reproducing apparatus as set forth in claim 58" is indefinite because it is not clear if the listed types of information are actually supplied to the apparatus or if the recitation set forth intended use of the information.

Clarification of the above is required.

Art Unit: 2621

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 61 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by notoriously well known “non-transitory content recording medium”. The following is noted:

A) The examiner notes that the first six words of claim 61 indicate that the claim is directed to “non-transitory content recording medium”, however, the remainder of the claim appears to be nothing more than a recitation of intended use and therefor has been given no patentable weight [Note part B of paragraph 3 of this Office action]; e.g., the recitations constitute non-functional descriptive material that fails to distinguish that which is claimed over the prior art.

B) The examiner takes Official Notice that “non-transitory content recording medium(s)” were notoriously well known in the art at the time of applicant’s invention. Such medium(s) anticipate claim 61 for the reasons addressed in part A of this paragraph.

Art Unit: 2621

6. Claim 58 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Document #2005/0152681 to Jung et al.

A) Preface:

1) It is the examiner's position that the applied reference of Jung et al is entitled to the priority date of the US Provisional application #60/508315 filed 10/6/2003; and

2) Regardless, i.e., even if applicant were to dispute this position, applicant cannot rely upon the foreign priority papers to overcome this rejection because:

a) A translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15; and

b) Not all of the priority documents antedate the filing date of the applied reference and, as such, it is unclear as to whether the required 112-1 support for that which is claim is found in that/those that do.

B) The showing of Jung et al.:

As shown in Figure 4, Jung et al. discloses a playback system comprising:

1) An acquiring section (e.g., @ 430 and/or 420) for acquiring information from a storage medium (@ 410) wherein the information includes:

1) Content information (e.g., @ 433);

2) Synchronization information (e.g., @ Figure 3 and "Table 1" on page 4) [Note: paragraph 0034-0054, and 0064]; and

3) a program (e.g., @ 431);

2) A program executing section (e.g., @ 440);

3) A synchronization control section (e.g., @ 460) [see paragraph 0058];

wherein the program and control sections operate as set forth in paragraphs 0058-0061 [and, for example, claims 24-27 on page 6].

7. Claim 59 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Document #2005/0152681 to Jung et al. for the same reasons explained above for claim 58.

Art Unit: 2621

8. Claim 60 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Document #2005/0152681 to Jung et al. for the same reasons explained above for claim 58. Additionally:

Note paragraph 0072.

9. Claim 61 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Document #2005/0152681 to Jung et al. for the same reasons explained above for claim 58.

10. Claim 62 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Document #2005/0152681 to Jung et al. for the same reasons explained above for claim 58.

Art Unit: 2621

11. The following references are noted:

- A) US Patent #7440675 (note Figure 3);**
- B) US Patent #6,580,870 (note Figure 16);**
- C) US Patent Document #2007/0122118 (note figure 3);**
- D) US Patent #2003/0229899 (note paragraph 0028);**
- E) US Patent #2002/0106193 (note the cover page & abstract).**

Art Unit: 2621

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621